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EXAMINER

PURVIS, SUE A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1734

DATE MAILED: 08/29/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/626,621

Applicant(s)

ANDERSON ET AL.

Examiner

Sue A. Purvis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The substitute specification filed 01 August 2002 has not been entered because it does not conform to 37 CFR 1.125(b) because: there is no marked up copy of the specification showing the changes.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-33 rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Krawczyk (US Patent No. 5,252,166) and Jensen, Jr. (US Patent No. 4,795,513).

Pages 1 and 2 of the instant specification teaches that previously a composite image was formed on the surface of a substrate manually by a skilled applicator who would pull or stretch each film slightly, thus varying its tension, as it was being applied to a maintain registration between the different panels used to form the composite image.

The admitted prior art does not teach using registration marks on the film and aligning those registration marks up.

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Krawczyk discloses a method of mounting multiple plastic sheets where the dimensions of the composite image are greater than the dimension of the plastic sheets. (Figures 17 and 18). Each portion has guidelines thereon for which are used to help align the design properly.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include guides or registration marks in the method of the admitted prior art, because while in some instances a skilled artisan only needs to look at the composite image in order to align it properly images on separate sheets, there are instances where guidelines or registration marks would be helpful in aligning images on separate sheets as taught by Krawczyk.

The admitted prior art in view of Krawczyk does not teach varying the tension on the second film along the length of the film to help ensure the marks are aligned properly.

Jensen, Jr. teaches forming a two-layered composite, 16, formed by the lamination of paper web, 14, with film web, 12. The paper layer, 14, has a perforated pattern, 24, and the plastic layer, 12, has a target area, 28, positioned in registration with the area, 24. A register control system is adapted to provide proper registration between the perforated pattern, 24, and the target area, 28. During operation the length of the film web is stretched or shrunk in order for it to be properly aligned with the paper web. (Col. 7, lines 12-65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the tension on the length second web thus stretching or shrinking the space between the registration marks, because Jensen, Jr. teaches such steps are known ways of aligning webs.

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Regarding claims 9-12, invisible and washable registration marks are within the purview of one having ordinary skill in the art, because it would be preferable that the alignment marks not be intrusive to the composite image.

Regarding claim 20, it is noted the film in Jensen, Jr. is fed in roll form, furthermore typically wallpaper or carpet, items which are applied to a static structure such as the instant invention, are typically stored in roll form.

Regarding claims 21 and 22, a length of 5 meters and 10 meters is within the purview of one having ordinary skill in the art. The admitted prior art states 3 meters, however an artisan would know that the longer the length of the web, the less likely two webs will need to be used side by side and less chance for improper alignment.

Response to Arguments

4. Applicant's arguments filed 20 June 2002 have been fully considered but they are not persuasive.

5. In response to applicant's argument that applying the teachings of Jensen to Krawczyk results in an undesirable result, applicant is reminded, the combination used by the examiner is the admitted prior art in view of Krawczyk and Jensen. The admitted prior art being the primary reference and Krawczyk relied upon solely for the use of reference marks along with decorative images. Jensen is relied upon to show that varying the tension in a web is known to be used when aligning webs. Thus, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375

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(Fed. Cir. 1986). Here, the proposed modification to the admitted prior art is to add reference marks, and then the teachings of Jensen are used. There is no suggestion of modifying the teachings of Krawczyk as set forth by the applicant.

6. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

7. Regarding claim 2, applicant sets out in claim 1, that the second film is dispensed “under tension along the length of the second film”; claim 2 states that this tension is “continuously applied to the second film during dispensing.” As a film is dispensed “under tension” it seems to the examiner that tension must be applied continuously for the “length” of the film to be under tension as stated in claim 1. This is shown in Jensen and admitted in the applicant’s art. When a film is dispensed or applied to a substrate, it must be so under a certain amount of tension, otherwise the film would become loose and bunch when adhered to another sheet, thus resulting in an undesirable outcome. Applicant’s own art admits a manual tensioning means, Jensen also has a tensioning means as shown in Figure 1 of Jensen. The webs are fed around cylinders (not numbered) which helps to maintain tensioned web, then through nip (62) which engages the web and varies the rate of transfer, thus controlling the tension in the web.

8. Regarding claims 3-5, 13, 15, 16, 32, and 33, see the arguments in paragraphs 5 and 6.

9. Regarding claim 6, it is within the purview of the artisan to remove registration marks if less reference marks are desired by the artisan. It is also preferable to an artisan to have

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reference marks which are not seen or at least hardly noticed in the final product. In Krawczyk, one embodiment discusses how the guidelines or reference lines are easily removable because they are made with an erasable marker. (Col. 16, lines 43-47). The artisan has no desire for the marks created for the sole purpose of lining up sheets of material to be noticed after installation is complete, thus they would either make the references so small that they are barely noticeable or have the capability of removing mark, as shown in Krawczyk.

10. Regarding claims 7 and 24, when joining two films together the films are stretched so that the registration marks line up, as a result one film may have a bit of excess which would result in removing a portion of the film along with the registration marks thereon. There could be a number of reasons for such an occurrence, such as one film's supply is greater than the other or the supply appears to be the same at first but by stretching the film to line up the references marks, the stretched film ends up having excess film. Another possibility is that the film is removed for the sole purpose of removing the reference marks, and this is an obvious alternative to washing off the reference marks and is also shown in Krawczyk. The pelican design in Figure 18 shows the design with the top sheets attached, the top sheets contain the guidelines. Once the adhesive is hardened, those top sheets are removed, thus the guidelines are removed. Thus it is the position of the examiner that to remove part of the sheet to remove the registration marks is within the purview of the artisan. This is also shown in a Hensley et al. (US Patent No. 6,354,984 B1) where reference marks are preferably confined inside trim areas (79) such that the cutting out of a respective trim area simultaneously (i) creates a desired new element of the work piece, namely the leg cut-out, and (ii) removes the reference mark which was used to register the graphic to the pad. (See Figures 3, 4, and 6; Col. 16, lines 65-68).

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11. Regarding claims 8 and 25, removing the film before it is applied to the substrate is a matter of choice and within the purview of one of ordinary skill in the art. The choices are before or after and the artisan would know when it is preferable to remove any excess. Mitchell (US Patent No. 4,490,198) shows the excess material being trimmed after it is applied to the substrate. Shannon (US Patent No. 4,806,184) discloses that the material is cut to the desired length prior to application to the substrate. In Fritz (US Patent No. 1,498,618), mentioned in Shannon, it is also taught to cut the sheet prior to applying to a substrate. When the film should be cut, before or after applying the film to the substrate is within the purview of the artisan to decide, since both ways are known.

12. Regarding claim 14, it is within the interests of the artisan to distribute the reference marks in regular intervals. The other option being irregular intervals which would not serve the purpose the artisan had designed the registration marks for. This is introduced in the applicants own admitted prior art as well as in Krawczyk and Jensen, and the examiner fails to see why the applicant could not find this in the cited documents on their own. (See Jensen Figure 2, Krawczyk Figures 17 and 18).

13. Regarding claim 17, a direct result of aligning the reference marks is the alignment of the portions of the composite image. The purpose of the reference marks is to ensure that the composite image is aligned. This is shown in Figures 17 and 18 of Krawczyk.

14. Regarding claim 18, Jensen teaches a control which detects the distances between the reference marks in order to ensure the film is lined up properly and since the web is in tension across its width, that distance is indicative of a position across the width of the web, to be

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otherwise would mean that one side of the web is stretched while the other being relaxed, thus creating a skewed web.

15. Regarding claim 19, applicant's own admitted prior art states the skilled applicator will stretch or pull each film slightly as it is applied to the substrate in order to maintain registration between the different panels.

16. Regarding claims 27-29, invisible and washable registration marks are within the purview of one having ordinary skill in the art, because it would be preferable that the alignment marks not be intrusive to the composite image. Washable marks are shown in Krawczyk as discussed in paragraph 10. Jensen discloses a mark (19) on one film, which would be invisible to the naked eye. Lerner et al. (US Patent No. 4,412,876) teaches a web position detector (64) which senses indicia on each successive label. The web position indicia are normally invisible, or nearly invisible, registration marks which are printed on each label.

17. Regarding claim 30, it is noted the film in Jensen, Jr. is fed in roll form, furthermore typically wallpaper or carpet, items which are applied to a static structure such as the instant invention, are typically stored in roll form.

18. Regarding claim 31, the length of the film being at least as great as the composite image is a design choice and based on what the composite image the artisan wants. In Krawczyk, the composite images on the films in Figures 17 and 18 are "at least as great" as the films length. In Shannon, the composite image is endless amounts of stars, whether this image is "at least as great" as the length depends on if the artisan considers the entire pattern to be the composite image or just one individual star. Thus it is the position of the examiner that to have the composite image "at least as great" as the length is within the purview of the artisan.

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19. Regarding claims 9-12, see the arguments in paragraph 16.
20. Regarding claims 20-22, see the arguments in paragraphs 5 and 6.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is 703-305-0507. The examiner can normally be reached on Monday through Thursday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

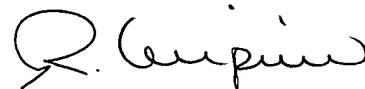
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.



Sue A. Purvis
Examiner
Art Unit 1734

sp
August 24, 2002



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